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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,781	08/11/2000	Axel Burmeister	Beiersdorf 630-	8467

7590 03/16/2004  
Norris McLaughlin & Marcus P A  
220 East 42nd Street  
30th Floor  
New York, NY 10017

EXAMINER
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LEE, RIP A

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/636,781

Applicant(s)

BURMEISTER ET AL.

Examiner

Rip A. Lee

Art Unit

1713



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action follows a response filed on December 29, 2003. Claims 1-3 and 5-7 remain for prosecution. Non-elected claims have not been rejoined at this time.

#### ***Claim Rejections - 35 USC § 102***

1. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,860,673 to Lawrence for the same reasons set forth previously (see previous office action and discussion below).

#### ***Response to Arguments***

2. Applicants traverse the rejection of claims 1-3 and 5-7 under 35 U.S.C. 102(b) in view of Lawrence. Applicant's arguments have been fully considered, but they are not persuasive.

With respect to the claims at hand, Applicants submit that the material of the prior art does not meet the present claims because it is derived from solution, and therefore, it is not a hot-melt pressure sensitive adhesive. While the materials are combined in solution, it is also noted that the resulting blend is applied as a thin film, and it was allowed to dry. Subsequently, the material was activated with infrared irradiation at 80 °C, and then the strips onto which the adhesive material was applied were pressed together. The material once applied is dry, and irradiation effects crosslinking. Application of heat would serve to melt the composition, and then pressure is applied to the strips so that they can be adhered together. Arguably, the final product, once solvent is removed, qualifies as hot melt adhesive.

Applicants decry the current rejection with the allegation that the examiner has treated the prosecution as a "scavenger hunt." Clearly, there is no basis for this statement. Present claim 1 is directed to a composition comprised of 100 pw non-thermoplastic elastomer, 1-200 pw tackifier, and a mixture of blocking agent free isocyanates in an amount to provide 6 mmole – 5 mole of NCO groups. Use of a mixture of isocyanates is discussed in claim 7, and it is shown in Example 2. In this case, there are about 0.48 g NCO groups per 100 g of base resin. The example also teaches use of tackifier resin in an amount of 25 pw. The claimed features have been laid out clearly without culling isolated parts (so called "picking and choosing") to build up an embodiment that meets the Applicant's claims.

In view of the discussion above, the rejection of record has not been withdrawn.

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Applicant's comments, not germane to the claims, have been noted. Applicants are reminded that amendments to claims raise new considerations. Therefore, examination of amended claims may require different search strategies. In this event, a previously cited reference may be viewed with a different perspective. There is no rule stating that art applied in an obviousness-type rejection can not be used later in an anticipation rejection. Furthermore, the examiner is not barred from using "recycled" references. Lastly, technical problems associated with facsimile transmission may be obviated by correspondence through the U.S. Postal service.

***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. The prior art made of record but not relied upon is considered pertinent to the Applicant's disclosure. The following references teach adhesive compositions comprised of blends of isocyanates.

U.S. Patent No. 5,977,283 to Rossitto

U.S. Patent No. 5,888,650 to Calhoun *et al.*

U.S. Patent No. 3,692,720 to Sloan

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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March 10, 2004



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